Remarks/Arguments

This Amendment is submitted in response to the Office Action mailed January 22, 2009. Claims 1-70, 72-77, 79, and 80 are rejected. In this Amendment, claims 1, 26, 70, 74-76, and 80 have been amended. No claims have been added or cancelled. It is respectfully submitted that the amendment does not add new matter. Applicants reserve all rights with respect to the applicability of the Doctrine of Equivalents. Applicants respectfully request consideration of the subject application as amended herein.

Claim Objections

The Examiner objects to claim 70, 74, and 75 because of informalities. Applicants have amended the claims as suggested by the Examiner to correct the noted informalities (Office Action, mailed 1/22/09, page 2). In light of the amendments, Applicants respectfully request withdrawal of the objection.

Claim Rejections Under 35 U.S.C. § 101

The Examiner rejects claims 1-25, 70, 72-73, 76-77, and 79 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants respectfully disagree.

The Federal Circuit has recently clarified how a method claim should be analyzed under 35 U.S.C. § 101 for patent subject matter eligibility. As clarified in *In re Bilski* 545 F.3d *943,* 88 USPQ2d 1385 (Fed. Cir. 2008), the test for determining whether a method claim is directed to statutory subject matter under § 101 is whether the method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. With respect to claim 1, Applicants have amended the claim to recite "receiving, at a server computer system, a plurality of requests for portions of a

JPM file across a network; and transmitting, at the server computer system, a JPM file ..."
to tie the claimed method to another statutory class (i.e., the "server computer system").
Thus, independent claim 1 is directed to statutory subject matter in view of *In re Bilski*.

Applicants have similarly amended independent claims 70 and 76 to positively tie
those claims to a particular machine or apparatus, and thus claim 70 and 76 are also
directed to statutory subject matter. Given that the remaining claims depend from one of
independent claims 1, 70, and 76, Applicants respectfully submit that the dependent
claims are also directed to statutory subject matter.

Therefore, Applicants respectfully submit that claims 1-25, 70, 72-73, 76-77, and
79 are directed to statutory subject matter.

Claim Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 1-70, 72-77, 79, and 80 under 35 U.S.C. § 103(a) as
being unpatentable over "JPEG 2000 Part 6 FCD 15444-6" of Buckley, et al (hereinafter
"Buckley") in view of Sharpe et al ("JPEG 2000 .jpm file format", hereinafter "Sharpe").
Applicant respectfully disagrees.

Buckley describes the JPM standard and the requirements necessary for a file to
comply with the standard. A JPM file consists of multiple pages, where a page is
represented as a layout object that may include an image object and/or a mask object for
the page (Buckley, sections 5.2-5.2.1). Buckley provides a narrative example for
searching an encyclopedia that is stored as a JPM file (Buckley, page 7). Furthermore, in
Annex G of Buckley, an informative guideline for constructing URLs that reference a sub
element of a JPM file is described. In particular, a URL in Buckley specifies a path to a
JPM file, a page, and an object (Buckley, page 73).

Sharpe describes JPEG 2000 features relevant to document imaging. One of the document imaging features of Sharpe includes the progressive refinement of a JPM file (Sharpe, page 473; Figure 5). A representation of the layout objects is first obtained and rendered (Sharpe, Figure 5(b); page 473, paragraph 1). Specific layout objects are then obtained and rendered to fill in the page representation (Sharpe, Figures 5(c) and 5(d); page 473, paragraph 2).

Amended claim 1 recites:

> A method comprising:
> receiving, at a server computer system, a plurality of requests for portions of a JPM file across a network; and
> transmitting, at the server computer system, a JPM file in parts across the network in response to the plurality of requests, wherein each of the parts is a legal JPM file, and
> wherein transmitting the JPM file comprises:
> transmitting a first legal JPM file corresponding to a first request of the plurality of requests; and
> transmitting a second legal JPM file corresponding to a second request of the plurality of requests, the second legal JPM file referring to the first legal JPM file.

(Emphasis Added)

That is, in accordance with claim 1, a plurality of requests for portions of a JPM file are received, and JPM file parts are transmitted in response to the requests. Each of the parts is a legal JPM file. A first legal JPM file is transmitted, which corresponds to a first request. Then a second legal JPM file is transmitted, which corresponds to a second request, and the second legal JPM file refers to the first legal JPM file.

Applicants respectfully submit that a combination of Buckely and Sharpe fail to describe or suggest "transmitting, at the server computer system, a JPM file in parts across the network in response to the plurality of requests, wherein each of the parts is a legal JPM file," or "transmitting a second legal JPM file corresponding to a second

request of the plurality of requests, the second legal JPM file referring to the first legal JPM file," as claimed.

Buckley describes the use of URLs for accessing specific objects in a JPM file (Buckley, Annex G). The URL includes a string that defines a page of a JPM file and the specific object requested, such as a specific object in the page or XML metadata for the page (Buckley, Annex G, Sections G.1-G.2). As described in Buckley, the specific object pointed at by the URL (i.e., layout object 2031 from page 17 or metadata for page 43) is returned. There is no hint or suggestion within Buckley that the URL, formatted to point to a specific object within a JPM file, returns legal JPM files. Thus, Buckley fails to describe or suggest transmitting parts of a JPM file for a plurality of requests where each part is a legal JPM file, and a first legal JPM file corresponds to a first request and a second legal JPM file corresponds to a second request.

Sharpe describes the progressive refinement of a JPM file for an initial shell representation of the JPM file (Sharpe, Figures 5(b)-5(d). Specifically a shell of a JPM file is first obtained, and then layout objects are added to the shell to refine the JPM file. Similar to the discussion above with respect to Buckley, Sharpe only describes adding layout objects to the initial JPM file representation. Sharpe, however, fails to describe or suggest that the progressive refinement with the layout objects is performed via legal JPM files, as claimed. Thus, Sharpe also fails to describe or suggest transmitting parts of a JPM file for a plurality of requests where each part is a legal JPM file, and a first legal JPM file corresponds to a first request and a second legal JPM file corresponds to a second request.

Therefore, a combination of Buckley and Sharp fail to describe or suggest "transmitting, at the server computer system, a JPM file in parts across the network in response to the plurality of requests, wherein each of the parts is a legal JPM file."

Furthermore, the Examiner states that Buckley fails to describe or suggest "transmitting a second legal JPM file corresponding to a second request of the plurality of requests, the second legal JPM file referring to the first legal JPM file," and therefore relies on Sharpe at page 473, paragraph 2 (Office Action, 1/22/09, page 4). As discussed above, Sharpe describes the interleaving of layout objects to progressively refine a JPM file (Sharpe, page 473). Merely noting that a JPM file may be refined by obtaining layout objects, provides no hint or suggestion that new and legal JPM files are transmitted for multiple requests and a "second legal JPM file referring to the first legal JPM file" is transmitted for the plurality of requests. Thus, Sharpe fails to cure the deficiency of Buckley, and a combination of Buckley and Sharpe fail to describe or suggest "transmitting a second legal JPM file corresponding to a second request of the plurality of requests, the second legal JPM file referring to the first legal JPM file."

Therefore, a combination of Buckley and Sharp fail to describe or suggest each and every limitation as claimed, and thus fail to render claim 1, and the claims that depend therefrom, obvious. Claims 26 and 51 contain similar limitations and features as those discussed above with respect to claim 1. Therefore, for at least the reasons discussed above, claims 26 and 51, and the claims that depend therefrom, are not obvious over a combination of Buckley and Sharpe.

Amended claim 70 recites:

A method comprising:

receiving, at a server computer system, a plurality of requests for portions of a JPM file across a network;

collecting, at the server computer system, boxes in the JPM file relevant to at least one of the plurality of requests for portions of the JPM file;

forming, at the server computer system, a new legal JPM file with the boxes that are relevant to the at least one request, including adjusting any references of the boxes to new locations in the new legal JPM file and eliminating pointers to external files; and

transmitting, at the server computer system, the new legal JPM file across a network.

(Emphasis Added)

That is, in accordance with claim 70, a plurality of requests for portions of a JPM file are received. Boxes in the JPM file are collected relevant to at least one of the requests. Then a new legal JPM file is formed with boxes relevant to the at least one request. Furthermore, during the forming, references of the boxes to new locations in the new JPM file are adjusted and pointers to external files are eliminated. This formed new legal JPM file is then transmitted.

Applicants respectfully submit that a combination of Buckley and Sharpe fail to describe or suggest "forming, at the server computer system, a new legal JPM file with the boxes that are relevant to the at least one request, including adjusting any references of the boxes to new locations in the new legal JPM file and eliminating pointers to external files," as claimed.

As discussed above, Buckley describes the components of a JPEG 2000 compliant file. Buckley further notes that an URL may be formatted to reference specific sub components of a JPM file (e.g., an URL referring to a layout object or page metadata). Merely accessing a sub component of a JPM file, however, does not describe or suggest forming a new **legal JPM file** with the boxes that are relevant to the at least one request.

The Examiner further cites Buckley at page 13 as describing adjusting box references and eliminating pointers to external files during the forming of the new legal JPM file. However, page 13 of Buckley describes fragment tables of the JPM file format. If there is a wholesale change to a fragment box in a file, the new fragment box may be post-pended to the file and the old fragment box turned into a free box (Buckley, page 13, paragraphs 3-5). Thus, at most, Buckley at most describes adding a new fragment box to an existing JPM file, but fails to describe or suggest adjusting box references and eliminating pointers to external files during the forming of the new legal JPM file.

Furthermore, Sharpe describes the progressive refinement of an existing JPM file, as discussed above. The progressive refinement is made by introducing layout objects into an initial image representation (Sharpe, page 473). Sharpe, however, is silent as to adjusting box references and eliminating pointers to external files during the forming of the new legal JPM file, and thus fails to remedy the shortcomings of Buckley.

Therefore, a combination of Buckley and Sharpe fails to describe or suggest "forming, at the server computer system, a new legal JPM file with the boxes that are relevant to the at least one request, including adjusting any references of the boxes to new locations in the new legal JPM file and eliminating pointers to external files," and thus fails to render independent claim 70, and the claims that depend therefrom, obvious.

Independent claims 74 and 75 contain similar limitations and features as those discussed above with respect to independent claim 70. Therefore, for at least the same reasons, claims 74 and 75 are also not obvious over a combination of Buckley and Sharpe.

Amended claim 76 recites:

>A method comprising:
>receiving, at a server computer system, a plurality of requests for portions of a JPM file across a network;
>transmitting, at the server computer system, the JPM file in parts across the network in response to the plurality of requests, wherein each of the parts is a legal JPM file;
>sending parts of the JPM file with an indication of the parts being sent across the network; and
>filling in gaps in a received legal JPM file with newly-created free boxes.

(Emphasis Added)

That is, in accordance with claim 76, a plurality of requests for portions of a JPM file are received, and JPM file parts are transmitted in response to the requests. Each of the parts is a legal JPM file. Furthermore, the parts of the JPM file are sent with an indication of the parts being sent, and gaps in a received legal JPM file are filled with newly-created free boxes. Applicants respectfully submit that a combination of Buckley and Sharpe fails to describe or suggest each and every feature as claimed.

Claim 76 recites in part "filling in gaps in a received legal JPM file with newly-created free boxes." The Examiner relies on Annex F of Buckley which describes XML encoding of JPM files (Buckley, page 63). In those passages, Buckley describes that a JPM file may be stored on a web server in the XML format. Then, an alternative JPM files may be derived as an XML file on the web server using XSLT (Buckley, page 63, paragraph 3). Although Buckley notes that an XML encoded JPM file may be created, Buckley is silent as to formatting, altering, etc. a **received** JPM file, and therefore fails to describe that gaps in a received legal JPM file are filled with newly-created free boxes. Sharpe describes refinement of a JPM file representation by adding received layout objects to the representation, but fails to address filling gaps with newly created boxes in

received legal JPM files. Therefore, a combination of Buckley and Sharpe fails to describe or suggest "filling in gaps in a received legal JPM file with newly-created free boxes," as claimed.

Applicants respectfully submit that a combination of Buckley and Sharpe fails to describe or suggest each and every feature of claim 76, and thus fails to render claim 76, and the claims that depend therefrom, obvious. Claim 80 includes similar limitations and features as those discussed above with respect to claim 76. Thus, for similar reasons, a combination of Buckley and Sharpe also fails to render claim 80 obvious.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-70, 72-77, 79, and 80 under 35 U.S.C. § 103(a) as being unpatentable over Buckley in view of Sharpe.

Conclusion

Applicant respectfully submits that in view of the amendments and discussion set forth herein, the applicable rejections have been overcome. Accordingly, the present and amended claims should be found to be in condition for allowance.

If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact the undersigned at (408) 720-8300.

If there are any additional charges/credits, please charge/credit our deposit account no. 02-2666.

Respectfully submitted,

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